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MAIL STOP APPEAL BRIEF - PATENTS
PATENTS
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE
THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Jan ERIKSSON

Serial No. 09/581,911

Appeal No. _____

Filed June 19, 2000

Group 3600

ANIMAL RELATED APPARATUS

REPLY BRIEF

MAY IT PLEASE YOUR HONORS:

This Reply Brief is in response to the Examiner's Answer of September 14, 2007.

Appellant is not in disagreement with Sections (1)-(9) of the Examiner's Answer (the "Answer").

Appellant is in disagreement with the Examiner as to Section (10) Response to Argument.

As stated in the Appeal Brief, the first ground of rejection on appeal is whether claims 1-4, 8-12, 19, and 20 were properly rejected as unpatentable under §103 over JAKOBSON in view of PAINE and WILLIAMS. The second ground of rejection on appeal is whether claims 5-7 and 16-18 were properly rejected as unpatentable in further view of INNINGS.

At the bottom of Answer page 3, the Examiner has alleged that "[the] claimed invention is merely a known mechanical preventative maintenance measure. The claimed steps and apparatus for registering a cumulative running value for a piece of mechanical equipment, using known circuitry to signal

when a predetermined value has been reached, and storing additional cumulative running values are old and notoriously well-known measures."

Appellant certainly disagrees and believes that it is clear that the record fails to support these allegations.

As noted by the Appeal Brief and the Answer, this is the second appeal in this case. PAINE and WILLIAMS were not considered in the first appeal; however, JAKOBSON and INNINGS were considered in the first appeal.

In the first appeal, the Board found that JAKOBSON elements 14 and 18 were not "registering means" but only proximity sensors, with no disclosed capability of or need for registering a cumulative running value (see sentence spanning pages 6-7 of Opinion date March 31, 2005, and Opinion paragraph spanning pages 7-8).

Regarding claims 5-7, which concern the second ground of rejection in view of INNINGS, in the first appeal, the Board found nothing in INNINGS that overcame the deficiencies of the other references (paragraph spanning pages 8-9 of the Opinion).

In the sentence spanning Answer pages 3-4, the Examiner has offered as examples of the invention being old and notoriously well-known, that "cars have a signaling warning light that comes on once the car has traveled a predetermined amount of miles to indicate an oil change or service is necessary." However, the Examiner has not indicated that this assertion is in the record, or shown that such signaling warning light was known at the time of making the present invention.

Note that appellant's priority extends back to December 19, 1997 when the Swedish priority application was filed (this case being the national phase of a PCT filed December 18, 1998).

The statute is clear that appellant is entitled to a patent unless, e.g., the invention was known or used by other ... before the invention thereof ... (35 USC §102(a)), and that a patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains (35 USC §103).

The Examiner's allegations about what is well known now, whether on the record or not, is not probative of what "would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains" pursuant to the statute.

Any findings as to what is well known now, without the record showing that these same things were well known at the time the invention was made, cannot be used in determining whether the presently claimed invention would have been obvious at the time the invention was made.

As to what was known at the time the invention was made, the Examiner makes merely a conclusory statement, which is not supported by the record.

In the first paragraph of Answer page 4, the Examiner has boldly alleged that "[t]he claimed technique and apparatus is an old and notoriously well-known application for mechanical

devices. In this instance, applicant is merely applying the known technique to the known mechanical components of a milking system. The modification here is the use of a known technique to improve a known mechanical device in the same way to yield predictable results."

Although the Examiner has made this bold allegation, the Examiner has failed to offer any system which has all the features of the claimed invention, but is in a different mechanical application, e.g., automotive. The absence of such an example is evidence that the invention is indeed non-obvious. This is at least a "secondary consideration" within the *Graham v. John Deer Co.* test, (383 U.S. 1, 148 USPQ 459 (1966)).

35 USC §103 is also clear in that "[p]atentability shall not be negatived by the manner in which the invention was made. In this vein, Appellant feels that the field of the invention (animal related operations) has unduly prejudiced an objective, hindsight-absent evaluation of the obviousness of the claims.

The Examiner recognizes that appellant has pointed out that the rejections arise from improper application of hindsight (Answer page 4, first full paragraph). The Examiner, citing to *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971), has responded by stating "any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge

gleaned only from the applicant's disclosure, such a reconstruction is proper."

However, as evidenced by the above-discussed paragraphs from Answer pages 3-4, this is not the approach that has been taken. The current rejections rest on a conclusion taking into account what is presently known, and then in hindsight working backwards to find references supporting the rejections.

In this regard, appellant notes that the Examiner has not made a factual determination as to resolving the level of ordinary skill in the pertinent art. Without this determination, the Examiner is not in a position to evaluate the question of obviousness. This is consistent with the recent Department of Commerce Examination Guidelines for Determining Obviousness (Federal Register/vol. 72, No. 195/Wednesday, October 10, 2007 57526, at 57527) where it is pointed out that "The *Graham* factors were reaffirmed and relied upon by the Supreme Court in its consideration and determination of obviousness in the fact situation presented in *KSR* ...".

Answer page 5, first full paragraph, states that PAINE was cited to teach establishing a threshold value, registering cumulative running value, and signaling when the threshold is reached. This statement is not inconsistent with the Appeal Brief.

The Reply, however, does not seem to dispute Appeal Brief pages 10-11 which point out that although PAINE teaches to have a registering means in order to register a cumulative running time for an apparatus (vehicle), PAINE does not teach

predetermined threshold values for discrete parts of a system and rather only teaches to notify that the whole apparatus (vehicle) should undergo services after a predetermined time. The Reply does not seem to dispute that PAINE does not teach monitoring running time related to an operation, the operation time being separate from the apparatus running time; to maintain separate cumulative running values, one cumulative running value for each functioning device, another cumulative running value for a robot that moving one of the devices, and still another cumulative running value for an overall related operation; and to have several threshold values, one threshold value for each functioning device, another threshold value for a robot that moving one of the devices, and still another threshold value for an overall related operation.

On page 6 of the Answer (lines 2-5), states (emphasis added) that "Williams was cited to teach it is general knowledge of one of ordinary skill to monitor the components of a mechanical system individually in conducting preventative maintenance practices (Williams Col. 2, line 1-10)." Appellant urges that the Examiner is reading more into this passage of WILLIAMS than is present.

First, in general, WILLIAMS teaches to compare a current manufacturing cycle with a previous manufacturing cycle or previous manufacturing cycle in order to detect a fault condition based upon a difference between the current cycle and the stored cycle(s). See the WILLIAMS Abstract lines 10-14. The WILLIAMS column 2, lines 1-10 passage does not teach to monitor components individually. The passage teaches that

"[t]he computer can further maintain a respective cycle count for each of at least one component...".

The Answer (page 6, lines 9-10) states that WILLIAMS satisfies the claim limitation of storing a cumulative running value and adding it to the previously stored value, citing to Column 4, lines 38-54. This passage refers to preventative maintenance device 10 monitoring and display wear information for various parts of manufacturing equipment. Wear information not understood to be cumulative running values. See lines 52-58 discussing maintenance schedules based on calendar time periods, e.g., daily, weekly, monthly, or yearly checks.

Even considering WILLIAMS, appellant does not see any teaching of predetermined threshold values for discrete parts of a system; monitoring running time related to an operation, the operation time being separate from the apparatus running time; to maintain separate cumulative running values, one cumulative running value for each functioning device, another cumulative running value for a robot that moving one of the devices, and still another cumulative running value for an overall related operation; and to have several threshold values, one threshold value for each functioning device, another threshold value for a robot that moving one of the devices, and still another threshold value for an overall related operation.

The Answer does not address each issue raised in the Appeal Brief.

On page 7 of the Appeal Brief, it is stated that as to the first ground of rejection, claims 1-4 and 8-10 stand together; claim 11 stands alone, and claims 12 and 19-20 stand

together. These claims include different recitations and were separately briefed (to the extent that the recitations differed).

The Answer does not address the specific claim recitations and is largely general in nature. For example, the Appeal Brief (page 13) pointed out that claim 1 recites the predetermined threshold value being set for each of the at least one animal related device, the robot and the complete animal related operation. The claim requires the Examiner show that establishing predetermined threshold values for all three of these items is obvious. It is not enough to show that one of the listed items would be obvious.

Appellant does not see that the Answer addresses this point.

For claim 11, the Appeal Brief points out (beginning at the bottom of page 13) that claim 11 also requires that "said control means is adapted to generate a maintenance-need signal when reaching predetermined threshold values corresponding to each of

i) said cumulative running value of said at least one animal related device,

ii) said cumulative running value of said robot, and

iii) said cumulative running value of said device used in said animal related operation,

so that said signal is automatically generated by said control means when said registering means registers any one of said cumulative running values reaching said corresponding predetermined threshold value".

Appellant does not see that the Answer addresses this point.

Appeal Brief page 15 points out that claim 12 is specific to a milking robot and milking an animal, and requires a control means adapted to generate a maintenance-need signal when reaching a predetermined threshold value corresponding to any of the cumulative running values, so that the signal is automatically generated when the registering means registers any of the cumulative running value reaching the corresponding predetermined threshold value.

Appellant does not see that the Answer addresses this point.

Appellant does not see that the Answer fully addresses the second ground of rejection, i.e., as to claims 5-7 and 16-18. The Appeal Brief acknowledges that INNINGS fairly show a pulsator, a teatcup with movement sensor, and an alarm to signal a malfunction in response to the sensor sensing a movement of the teatcup liner. More specifically, INNINGS fairly teaches an alarm to signal a malfunction in response to the sensor sensing an abrupt movement of the teatcup liner when the teatcup liner moves to an open or closed position. Further, see the Abstract of the reference which clearly discloses that "[i]f the sensed movement does not fulfill a predetermined condition, a malfunction is signaled."

However, the Answer has not addressed that the teaching of INNINGS is exactly opposite to that recited. That is, claim 1 recites to generate a signal when a predetermined threshold value has been reached whereas INNINGS teaches to signal if the predetermined condition is not fulfilled.

Further, the INNINGS alarm is not related to the running value of the pulsator (claim 5), e.g., the running time of the pulsator (claim 6), or the number of pulsations generated (claim 7). There is no disclosure as to a control means being adapted to register the cumulative running time value of said pulsator per claim 5. Accordingly, appellant urges that INNINGS fails to render obvious these claims.

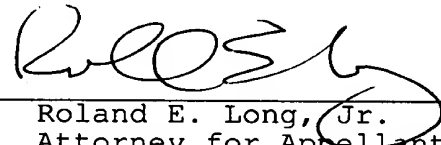
Summary

In view of Appellant's Appeal Brief and the foregoing Reply, it follows that both grounds of rejections are improper and should be reversed. Accordingly, reversal of the pending obviousness rejections is respectfully solicited.

Respectfully submitted,

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